

REMARKS

Claim 16 has been amended. Claims 2–5, 7–12, 14–17, and 19–20 are currently present in this application. In view of the foregoing amendments, and the remarks that follow, Applicants respectfully request reconsideration.

Objection to Premature Finality

Applicants respectfully traverse the finality of the Office Action. More specifically, MPEP §706.07(a) specifies that an Office Action shall not be final “where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims, nor based on information submitted in an information disclosure statement.” The claim rejections in the present Office Action are not identical to the claim rejections in the most recent prior Office Action, but instead include a number of changes that raise new issues.

By way of example and not limitation, at the bottom of page 3 of the present Office Action, a prior ground of rejection under 35 U.S.C. §101 for Claims 16–18 has been modified to now reject Claims 14–17. Claims 14–15 were not previously rejected under 35 U.S.C §101, and so the present Office Action presents a new ground of rejection. In more detail, Applicants’ last Response canceled independent Claim 13 and added the limitations of Claim 13 to dependent Claim 16, thereby converting original Claim 16 from dependent form to independent form. Claims 14–15, which originally depended from Claim 13, were amended to depend from Claim 16. The new ground of §101 rejection covering Claims 14 and 15 is directed to the recitation in the preamble of a “computer readable medium”. This language was present in originally-filed Claims 14 and 15, and was not added by amendment. Accordingly, since the phrase “computer readable medium” appeared in originally-filed Claims 14–15, and has never been amended, this phrase did not necessitate the new ground of rejection that has been applied to it.

As another example, on page 4 of the Office Action, a prior ground of rejection under the first paragraph of 35 U.S.C. §112 specifically referred only to Claim 1 but has now been

modified to present new grounds of rejection as to Claims 2–5, 7–12, 14–17, and 19–20. In regard to Claim 16, it should be noted that Claim 16 was changed from dependent form to independent form, but the scope of Claim 16 was not changed in Applicants' last Response. Also, on page 4 of the Office Action, the basis and rationale for the §112 first paragraph rejection has been modified, resulting in a new ground of rejection. Specifically, for the first time, the Examiner defines "denying" as requiring "a requestor and a denier." In addition, the previous rejection based its reasoning on "one router denying access to another router," whereas the present rejection bases its reasoning on "the second network, or any other entity, denying access to the first router." The Examiner's shift in rationale from "another router" to a "second network" was not in response to any claim amendment made by Applicants. In fact, the recitation of "denying the first router any access to the second network" was present in the originally-filed claims (for example originally-filed Claims 6 and 18).

These multiple new grounds of rejection are not in response to any claim amendments made in Applicants' last Response, nor are they based on art newly-submitted in an information disclosure statement. Instead, this is a situation "where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement." Consequently, in accord with MPEP §706.07(a), it is respectfully submitted that the finality of the pending Office Action is not proper, and must be withdrawn. Notice to that effect is respectfully requested.

Compliance With 35 U.S.C. §101

Claims 14–17 are rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. More specifically, on page 3 the Office Action asserts (1) that the recitation of a "computer readable medium" enables the claims to "encompass a software-only embodiment and to encompass signals and waves," (2) that software and signals "do not fall within any of the statutory categories," and (3) that "[t]he medium must be clearly hardware only." The Office Action further states on page 2 that the recitation of a "computer readable medium" is a "broad

limitation that encompasses non hardware elements, like signals, waves, software data structures, etc.”

Applicants note that Claim 16 includes the phrase a “computer readable medium comprising a plurality of instructions for execution by at least one computer processor”, which is explicitly stated in MPEP §2106.01(I) to be statutory subject matter under §101 (as explained in detail on page 7 of Applicants’ last Response). But subsequent to filing of Applicants’ last Response, in August 2009, the USPTO issued “Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. §101,” and these Instructions state on page 1 that they “supersede previous guidance on subject matter eligibility that conflicts with the Instructions, including MPEP . . . 2106.01 . . . ”. In these new Instructions, the USPTO has adjusted its position regarding statutory subject matter under §101. More specifically, on page 2, the Instructions state that “a claim to a computer readable medium that can be a compact disc or a *carrier wave* covers a non-statutory embodiment.” On page 4, the Instructions explain that “a claim to a non-transitory, tangible computer readable storage medium *per se* that possesses structural limitations under the broadest reasonable interpretation standard . . . would be patent-eligible subject matter” (emphasis added). Accordingly, in direct response to the USPTO’s change in position on this point, Applicants have amended the preamble of Claim 16 to recite a “computer readable medium that stores a plurality of instructions for execution by at least one computer processor.” This amendment does not change the intended scope of Claim 16. In view of the foregoing, Applicants respectfully submit that, under the USPTO’s new policy, amended Claim 16 recites statutory subject matter under §101. Claims 14–15 and 17 depend from Claim 16. Thus, Applicants respectfully request that the §101 rejection of Claims 14–17 be withdrawn.

Compliance With the First Paragraph of 35 U.S.C. §112

The Office Action rejects Claims 2–5, 7–12, 14–17, and 19–20 under the first paragraph of 35 U.S.C. §112, asserting they fail to comply with the enablement requirement. In particular,

the Examiner asserts that the recitation in Claim 1 of “denying the first router any access to the second network” is not supported in the specification, and specifically states on page 4 that “[t]here is no mention of the second network, or any other entity, denying access to the first router, and how this is performed.” Applicants respectfully traverse this rejection.

Claim 1 was previously canceled, and so the Examiner’s discussion of Claim 1 is moot. Applicants note that Claims 4 and 16 recite “denying the first router any access to the second network,” and Claim 19 recites “the first router is denied access to the company intranet.” Applicants will thus assume, for purposes of responding to the Office Action, that the Examiner meant to refer to Claims 4, 16, and 19 when discussing claim language that recites “denying.”

MPEP §2111 states that “claims must be ‘given their broadest reasonable interpretation consistent with the specification.’” Here, on pages 2–3 and 4, the Examiner improperly adopts an unduly narrow interpretation of the claim language “denying,” by twice asserting that:

“Denying’ occurs only in the presence of a requestor and a denier, where the requestor is denied by the denier. In this case, the first router would be the requestor. And in this case, Applicants disclosure does not support ‘denying’.

However, this interpretation fails to comply with MPEP §2111, because it is narrower than the “broadest reasonable interpretation” of “denying.” By way of example and not limitation, “denying” may occur without a requestor, for example when a physical structure is configured to prevent access to something, such as a network. On page 6 of the Office Action, in a different rejection, the Examiner interprets the term “denying” more broadly than in the §112 rejection, stating that “‘denying the first router any access to the second router’ . . . is therefore broadly interpreted to mean denying a user of one network to access the other network.” Thus, the Examiner clearly recognizes on page 6 that “denying” does not require a requestor and a denier, in direct contrast to the Examiner’s contentions on page 4 of the Office Action. Accordingly, in the §112 rejection, the Examiner has unnecessarily narrowly interpreted the meaning of “denying”

the first router any access to the second network,” by failing to give this language its “broadest reasonable interpretation” as required by MPEP §2111.

In any event, the present application provides support for "denying" as recited in the claims. In this regard, MPEP §2163(I)(B) provides that “[t]he claims as filed in the original specification are part of the disclosure.” Further, the second paragraph of 35 U.S.C. §112 specifies that the original claims are part of the specification. In the present application, originally-filed Claims 6 and 18 each recited “denying the first router any access to the second network.” In previous Responses filed on October 3, 2008 and April 16, 2009, this limitation from original Claim 6 was incorporated into Claim 1, which in turn was incorporated into Claim 4. Similarly, this limitation from original Claim 18 was incorporated into Claim 13, which in turn was incorporated into Claim 16. Since this limitation was present in the originally-filed claims, the present application (as originally filed) provides support for “denying the first router any access to the second network,” as presently recited in Claims 4 and 16.

Further, considering the specification and drawings, the present application clearly enables one of ordinary skill in the art the ability and know-how for “denying the first router any access to the second network” and for ensuring “the first router is denied access to the company intranet.” Originally-filed Figure 3 of the present application is reproduced below:

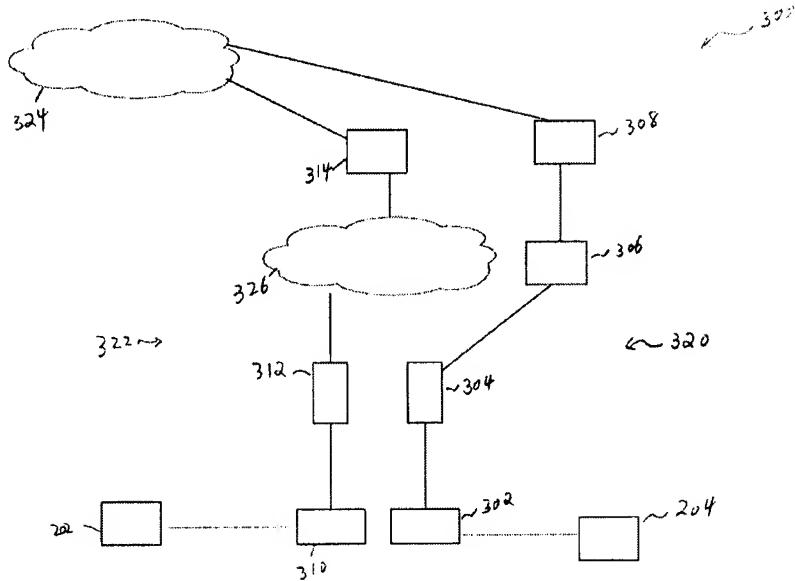


Fig. 3

By way of example and not limitation, it is clear from Figure 3 that a router 312 can access both a network 324 and an intermediate network 326. In contrast, a router 304 can access only the network 324, and is clearly denied access to the intermediate network 326. Regarding Figure 3, the originally-filed specification provides in paragraphs [0024]–[0025], [0047]–[0048], and [0053] that “the router 304 may route the connection from the access point 302 to the proxy server 306”, “the proxy server 306 may provide the external entity with an access to the network 324”, and an “[e]xemplary configuration for the proxy server 306” includes “deny[ing] company intranet web access,” while “allow[ing] all Internet web access.” Thus, Figure 3 and the accompanying description clearly support the recitation in Claims 4 and 16 of “denying the first router any access to the second network”, and the recitation in Claim 19 of “the first router is denied access to the company intranet.” A person of ordinary skill in the art can easily build and use what is shown in Figure 3, and the present application thus provides an enabling disclosure of a system that inherently involves “denying” as recited in the claims.

Moreover, MPEP §2164.01 discusses the standard for meeting the enablement requirement in the first paragraph of 35 U.S.C. §112, as follows:

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term “undue experimentation,” it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telecommunications, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). (underlining added).

In light of the foregoing, the present specification, coupled with information known in the art, clearly enables one reasonably skilled in the art to easily build the system of Figure 3 and thus accomplish “denying the first router any access to the second network” without undue experimentation.

For the foregoing reasons, Applicants respectfully submit that the present application as originally filed (including the specification and drawings) fully enables one of ordinary skill in the art to make and use Applicants’ system for “denying.” In particular, the present application enables one of ordinary skill in the art to accomplish “denying the first router any access to the second network” as recited in Claims 4 and 16, and to ensure “the first router is denied access to the company intranet” as recited in Claim 19. Thus, Applicants respectfully submit that the §112 first paragraph rejections should be withdrawn, and notice to that effect is respectfully requested.

Independent Claim 4

The Office Action rejected Claim 4 under 35 U.S.C. §103 on the ground that it would be obvious to modify Myers U.S. Patent Application Publication No. 2004/0122956 in view of Kim

U.S. Patent Application Publication No. 2005/0005110 and Hericourt U.S. Patent No. 6,792,461. This ground of rejection is respectfully traversed. In this regard, the PTO specifies in MPEP §2142 that:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

Applicants respectfully submit that the teachings drawn from Myers, Kim, and Hericourt fail to establish a *prima facie* case of obviousness under §103 with respect to Claim 4, for the following reasons.

NO VALID REASON IS GIVEN FOR MODIFYING MYERS IN VIEW OF HERICOURT

The requirements for properly establishing a *prima facie* case of obviousness are discussed in MPEP §2142, which emphasizes that:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F. 3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Claim 4 of this application includes a recitation of “routing to a proxy server through the first router.” The Examiner admits on page 7 of the Office Action that “Myers and Kim fail to explicitly teach routing to a proxy server through the first router.” The Examiner therefore turns to Hericourt, stating on page 7 that:

Hericourt discloses routing to a proxy server through a router where the proxy server is connected to the Internet (column 11 lines 9-18). Hericourt teaches that the proxy servers are utilized for the purpose of locally caching HTTP data from the Internet and providing the cached data to a workstation that sends a request for that particular HTTP data (column 11 lines 14-25).

The Examiner then asserts that it would be obvious to modify Myers in view of Hericourt so that the system of Myers can cache data. Specifically, on page 7 of the Office Action, the Examiner proposes the following reason or “motivation” for making the proposed modification to Myers in view of Hericourt:

It would have been obvious for one of ordinary skill in the art to modify Myers and Kim by routing to a proxy server through the first router as per the teachings of Hericourt. One would be motivated to do so for the purpose of utilizing the proxy servers as cache servers in order to locally cache HTTP data from the Internet and then provide it to a workstation that sends a request for that particular HTTP data, and which increases efficiency.

However, this reasoning is flawed. In fact, in the “Response to Arguments” section on page 3 of the Office Action, the Examiner offers comments supporting Applicants’ assertion that the motivation proposed by the Examiner is not sufficient to support a *prima facie* case of obviousness, because it would not actually motivate a person of ordinary skill to make the

proposed modification to Myers. More specifically, on page 3 of the Office Action, the Examiner states that:

[R]egarding beginning of second full paragraph of pg 12 of remarks, the rejection did not state that Myers fails to provide caching. The mentioned local caching in the rejection is local to the proxy, ie proxy caching.

This is exactly Applicants' point. In particular, for one of ordinary skill in the art to be motivated into "utilizing the proxy servers [of Hericourt] as cache servers in order to locally cache HTTP data from the Internet" so as to increase the efficiency of the Myers system as the Examiner contends, it must first be established that Myers fails to provide for caching data, or that even if Myers caches data, Myers does so inefficiently. But there is no evidence to support the notions that (1) the system of Myers cannot cache data or (2) the system of Myers cannot cache data efficiently. Consequently, there is no motivation for modifying Myers in view of Hericourt to provide caching capability. Instead, one of ordinary skill in the art would recognize that combining Myers and Hericourt would result in a more expensive and complex configuration. Since the Examiner agrees that Myers provides caching, and has failed to show that Myers does so inefficiently, there is no reason to incur the added expense and complexity of combining Hericourt's proxy server with the system of Myers, because there is no reason to expect any added benefit.

Further supporting Applicants' position, the Myers specification coupled with information already known in the art leads one of ordinary skill in the art to recognize that (1) the system of Myers can cache data and (2) there is no reason to believe Myers caches data inefficiently (other than improper use of hindsight by the Examiner). More particularly, at the time the present application was filed, local caching of Internet data was very well known in the art. Caching data is performed in a number of ways, including the use of web caches (for example as employed by web browsers), and other suitable caching techniques. One of ordinary skill in the art would readily recognize that the system of Myers is entirely capable of caching

Internet data without the use of Hericourt's proxy server. For example, Myers explains in paragraphs [0041] and [0051] that "mobile units 30 associated with customers and partners are provided access to the Internet 56," and that the mobile units can be "a laptop, personal digital assistant (PDA) or other device." One of ordinary skill in the art would recognize, based on industry-standard technology, that the mobile units 30 of Myers presumably already provide Internet caching (for example via standard web browsers utilized to access the Internet), thereby making it completely unnecessary to add a proxy server for the purpose of performing these same caching functions. Accordingly, the motivation proposed by the Examiner is not sufficient to support a *prima facie* case of obviousness, because it would not actually motivate a person of ordinary skill to make the proposed modification to Myers.

It appears that the idea to modify Myers in view of Hericourt is not coming from what was known before the present invention, but instead is coming from hindsight of Applicants' disclosure. In particular, using Applicants' disclosure as a blueprint, the Examiner has selectively extracted isolated features from Myers, Kim, and Hericourt, and has then combined these isolated features with a 20/20 hindsight view of the desired result. However, the proper inquiry is whether, if Applicants' disclosure is completely ignored, there is any reason that would prompt a person of ordinary skill to make the proposed modification of Myers in view of Kim and Hericourt. Here, a person of ordinary skill in the art would recognize that the system of Myers is apparently already capable of efficiently caching data, and the Examiner has not identified any valid reason that would prompt the proposed modification of Myers to add the proxy server of Hericourt.

In view of each of the reasons discussed above, it is respectfully submitted that the Examiner has failed to properly establish a *prima facie* case of §103 obviousness for Claim 4 based on Myers, Kim, and Hericourt. Claim 4 is therefore believed to be allowable, and notice to that effect is respectfully requested.

Independent Claim 16

The Office Action rejected Claim 16 under 35 U.S.C. §103 on the ground that it would be obvious to modify Myers in view of Kim and Hericourt. Applicants respectfully traverse this rejection. Claim 16 recites “routing to a proxy server through the first router.” The rationale given in the Office Action for this rejection of Claim 16 is precisely the same rationale given for the rejection of Claim 4. For reasons similar to those discussed above in association with Claim 4, it is respectfully submitted that Claim 16 is not rendered obvious under §103 by Myers in view of Kim and Hericourt. Claim 16 is thus believed to be allowable, and notice to that effect is respectfully requested.

Independent Claim 19

The Office Action rejected Claim 19 under 35 U.S.C. §103 on the ground that it would be obvious to modify Myers in view of Kim and Hericourt. Applicants respectfully traverse this rejection. Claim 19 recites “a first router for serving the first access point and routing the first computing device to a proxy server for providing access to the Internet.” The rationale given in the Office Action for this rejection of Claim 19 is precisely the same rationale given for the rejection of Claim 4. For reasons similar to those discussed above in association with Claim 4, it is respectfully submitted that Claim 19 is not rendered obvious under §103 by Myers in view of Kim and Hericourt. Claim 19 is thus believed to be allowable, and notice to that effect is respectfully requested.

Dependent Claims

Claims 2–3, 5, and 7–12, Claims 14–15 and 17, and Claim 20 respectively depend from Claim 4, Claim 16, and Claim 19, and are also believed to be allowable over the art of record, for example for the same reasons discussed above in association with Claims 4, 16, and 19, respectively.

Appl. No. 10/806,967
Reply to Office Action of August 20, 2009

Attorney Docket No. 2003-0571 / 24061.112
Customer No. 42717

Conclusion

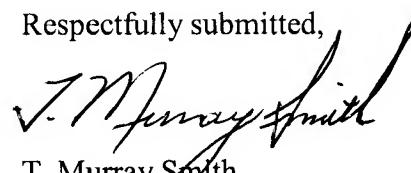
Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at (972) 739-8647.

Although Applicants believe that no additional fee is due, the Commissioner is hereby authorized to charge any fees required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone, LLP.

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Enclosures: None

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